

REMARKS

For the sake of clarity, claims 9, 10, and 13 have been amended. In claim 9, the first feature has been amended to include certain clarifying enumerations. That is to say, the program administer system is recited to be configured: (i) to be in communication with the at least one retailer to receive a first targeted advertisement and (ii) to receive a recorded profile from the at least one potential respondent to the advertising program. The message generator is configured to be connected to at least one of the at least one potential respondents. At least one of the plurality of saver cards is configured to be associated with each of the at least one potential respondents. Claim 10 has been amended to call for the message generator to be programmed to generate the first message. Claim 13 has been amended to call for the correlator to be configured to generate advertisement effectiveness data.

In order to emphasize the patentable distinctions of applicant's invention over the prior art, claims 1 and 9 have been amended to delineate a retailer having a retailer store, i.e. a physical location at which purchase transactions by customers may be carried out in the ordinary course of business. Method claim 1 calls for the at least one transaction to be carried out at the retailer store. System claim 9 calls for the program administrator system to be configured to receive an activation carried out at the retailer store.

Support for the foregoing amendments is provided by the specification, e.g. at page 4, line 22 through page 5, line 16; page 7, lines 7-22; page 8, lines 16-22; page 11,

lines 7-11; page 11, line 21 through page 12, line 4; and at the Abstract. Consequently, no new matter has been added.

The present method and system provide a versatile mechanism for the delivery of advertising material specifically targeted to potential consumers of goods or services, e.g. by tailoring the advertisements to a demographic profile of particular consumers. Such a targeting enhances the cost effectiveness of the advertising and minimizes the negative reactions often associated with the promotion of goods or services in which a particular consumer has no interest. The association of the program with a saver card further enhances the effectiveness of the present method and system. The saver card used in the practice of the present invention may be read at a retailer's store premises.

Claims 9-15 were rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner has stated that claims 9-13 [*sic - claims 9-15 may have been intended*] are system (apparatus) claims, yet they are said to set forth apparent method steps, rather than structure or components configured with certain capabilities. It is further said that it is unclear what structure is being claimed that is capable of performing the claim language.

Claims 9, 10, and 13 have been rewritten as set forth above. It is respectfully submitted that any indefiniteness resulting from the recitation of apparent method steps has thereby been mooted. In particular, claim 9 now calls for: (a) a program administrator system that is configured: (i) to be

in communication with the at least one retailer to receive a first targeted advertisement and (ii) to receive a recorded profile from the at least one potential respondent to the advertising program; (b) a plurality of saver cards appointed to be distributed to respondents; and (c) a message generator that is configured to generate a first message in accordance with the first targeted advertisement. Applicant respectfully maintains that the foregoing structural elements are in fact structurally defined, notwithstanding the functional language descriptive of the actions that these elements may perform during operation of the claimed system. It is further submitted that claims 11-13 also define the structure of various of the system elements in functional terms. Applicant respectfully observes that the courts have repeatedly affirmed the propriety of using functional language to recite a structural feature in a claim. *In re Schreiber*, 128 F.3d 1473, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997), quoting *In re Swinehart*, 439 F.2d 210, 212, 169 USPQ 226, 228 (CCPA 1971) ("[T]here is nothing intrinsically wrong with [defining something by what it does rather than what it is] in drafting patent claims.").

As now amended, claim 10 clearly recites the message generator as being responsible for generating a message.

Claim 13 has been amended in accordance with the Examiner's suggestion that the correlator is configured to carry out generation of advertisement effectiveness data.

Appreciation is expressed for the Examiner's constructive suggestions with respect to the foregoing claims.

The Examiner has not set forth any separate basis for the rejection of claims 14-15. Applicant thus presumes the rejection of these claims is based solely on alleged defects inherited from base claim 9 and intervening claim 11.

In view of the amendment of claims 9, 10, and 13 and the foregoing remarks, it is maintained that any lack of clarity in claims 9-15 has been obviated.

Accordingly, reconsideration of the rejection of claims 9-15 under 35 USC 112, second paragraph, as being indefinite is respectfully requested.

Claims 9-15 were also rejected under 35 USC 101 as being directed to non-statutory subject matter. The Examiner has indicated that these claims are system (apparatus) claims but has inferred that certain features of the claims, viz. a retailer, and a respondent, are human beings.

Applicant acknowledges that the terms “retailer” and “respondent” may refer to individual human beings, as well as to corporate institutions. However, applicant maintains that neither the “retailer” nor the “respondent” are recited as claimed elements that would give rise to a proper rejection of the invention as being directed to non-statutory subject matter. For example, the system of claim comprises a programmer administrator system “configured to be in communication with the at least one retailer” and configured to “receive from the ... respondent.” These recitations do not attempt to claim either the retailer or the respondent, but merely to recite structural requirements limiting the claimed system to one that has the communication capability afforded by the program administrator system element of the claim. As now amended, claim 9 further recites the message generator element as being configured to be connected to the potential respondents.

The presence in the claim 9 preamble of the terms “retailer” and “respondent” provides antecedent basis for the subsequent occurrences of those terms in the claim body. While the claimed system is configured to interact with such entities, it is submitted that the amended claim language clearly indicates to a skilled artisan that the claimed system does not include actual persons as claimed elements. Rather, such entities are employed only as antecedents for the functional recitation of elements that are clearly inanimate structural features. Applicant thus maintains that any basis for rejecting claims 9-15 as being directed to non-statutory subject matter has thereby been mooted.

Accordingly, reconsideration of the rejection of claims 9-15 under 35 USC 101 as being directed to non-statutory subject matter is respectfully requested.

Claims 1-15 were rejected under 35 USC 103(a) as being unpatentable over US Patent 7,158,943 to van der Riet in view of US Patent Publication US20020046116 to Hohle et al.

Applicant respectfully observes that the ‘943 patent issued January 2, 2007, from US Patent Application Serial No. 10/233,677, which was filed on September 4, 2002, a date subsequent to February 6, 2002, the filing date of the instant application. The van der Riet application was published as US 2003/0126146 on July 3, 2003. Clearly, neither the ‘943 patent nor the ‘146 patent publication is available as prior art under 35 USC 102(b) against the present application.

The van der Riet application claims benefit of US Provisional Patent Application Serial No. 60/316,268. Applicant maintains that the van der Riet '943 patent (and the '146 published application) are available as prior art under 35 USC 102(e) only to the extent the subject matter therein is disclosed and enabled by the provisional patent application.

In the present instance, the Examiner has applied the '943 patent under 35 USC 102(e) and cited certain passages therein in combination with Hohle et al. patent publication. He has alleged that this combination renders unpatentable the subject matter of claims 1-15.

Applicant has reviewed the on-line version of the provisional patent application Serial No. 60/316,268 available through Public Pair. However, applicant has been unable to locate any disclosure or suggestion in the provisional application of the "loyalty card" purportedly provided by van der Riet. The loyalty card was apparently added only by way of the later filing of the utility application.

The Examiner has admitted that the van der Riet provisional application does not disclose the use of a loyalty card apparently added only by the later filing of the utility application, and so has combined Hohle et al. as allegedly providing this feature.

Applicant further maintains that the van der Riet provisional application is directed exclusively to purchase transactions carried out on-line. As such, the functionality of applicant's saver card, which bears readable identifying indicia, is neither required nor needed to accomplish the targeting of advertisements. On the other hand, it is only in light of applicant's own disclosure, prior to the filing date of the utility

application that ultimately issued as the van der Riet '943 patent, that there is any teaching concerning the association of a saver card that may be read into the system at a retailer's physical location. Significantly, the van der Riet provisional application distinguishes his disclosed system from traditional "brick and mortar" retailers. *See, e.g.*, paragraph 2 at page 1. The van der Riet provisional application further points to the disclosed "portal branded shopping tool" as allowing customers "to buy conveniently, securely via 'escrow service' while enjoying privacy protection and loyalty point rewards." "Key Idea #13 at page 6. Applicant submits that this disclosure clearly establishes the van der Riet provisional system as being directed to electronically-consummated transactions which are distinguished from traditional retail transactions at a physical retail store. Applicant maintains that the significant reconstruction that would be required to modify any system provided by the van der Riet provisional application, even in combination with the Hohle et al. reference, precludes a proper finding of obviousness of claims 1 and 9, or claims 2-8 and 10-15 dependent thereon.

In view of the amendment of claims 1, 9, 10, and 13 and the foregoing remarks, it is respectfully submitted that the method of claims 1-8 and the system of claims 9-15 are not obvious over the combination of van der Riet and Hohle et al.

Accordingly, reconsideration of the rejection of claims 1-15 under 35 USC 103(a) as being unpatentable over van der Riet and Hohle et al. is respectfully requested.

In view of the amendment to claims 1, 9, 10, and 13, and the foregoing remarks, it is respectfully submitted that the present application has been placed in allowable

condition. Reconsideration of the rejection of claims 1-15 and allowance of the present application, are, therefore, earnestly solicited.

Respectfully submitted,

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